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| 67141 7590 12/16/2008 ALSTON & BIRD, LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000 | | | EXAMINER LOFTIS, JOHNNA RONEE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/848,519
Filing Date: May 04, 2001
Appellant(s): BESHORE, DAVID G.

Andrew T. Spence
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/14/07 appealing from the Office action mailed 5/10/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 15-20 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101

process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 and 15-20 are non-statutory since they may be performed within the human mind.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

"Evaluation Report for Grant #R13 HG00793-0142" Impact of Human Genome Initiative on Society: A Women's Study Approach. from www-unix.oit.umass.edu as accessed by web.archive.org, Feb. 2, 1999

NOTE: Appellant refers to this reference as Wilkinson, whereas, Examiner has referred to this reference as the WAGICS Evaluation Report throughout prosecution.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 15-20 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 and 15-20 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the WAGICS Evaluation Report.

As per claim 1, WAGICS Evaluation Report teaches acquiring information concerning the organization and the process (table 3, page 6 – the principles that are evaluated are inherently reflective of the organization and the process); developing a plurality of preliminary findings based upon the information, developing the plurality of preliminary findings including characterizing and labeling each preliminary finding with an associated characterization selected from a group consisting of a strength and a weakness (table 3, page 6 – the principles that are evaluated are reflective of the organization and the process and are inherently characterized as strengths or weaknesses); voting for a conclusion associated with each preliminary finding, and wherein the conclusion associated with each preliminary finding is selected from a group consisting of an agreement with the preliminary finding and a disagreement with the preliminary finding (table 3, page 6 – participants assess their agreement or disagreement with each of the principles); and developing a plurality of final findings, developing the plurality of final findings including characterizing and labeling each final finding with the characterization, and wherein the plurality of final findings are based upon said voting for the conclusion associated with each preliminary finding (table 3, page 6 – the table reflects the final findings wherein percentages are

used to show overall agreement or disagreement with each of the principles). While the WAGICS Evaluation Report does not disclose that the voting occurs electronically, it is old and well known in the art of survey and evaluation to collect responses in several methods including electronic form. It would have been obvious to one of ordinary skill in the art to perform the voting step electronically to speed the process and to make the voting process more convenient for the participants. In addition, WAGICS does not explicitly teach that the findings are labeled with the characterizations. However, examiner takes official notice that since each finding in the WAGICS report is written in such a way so as to include an inherent characterization, i.e., “suggested reading were *useful* in accomplishing workshop goals” inherently conveys a strength, it would have been obvious to one of ordinary skill in the art to actually label the findings. The inclusion of a label would provide more information for the assessor to enable him or her to provide a most accurate assessment of the organization.

As per claim 2, WAGICS Evaluation Report does not explicitly teach how the preliminary information is acquired, but the tables show that information was collected to develop preliminary findings of the workshop (principles). It would have been obvious to one of ordinary skill in the art to use several methods to acquire information including a plurality of questionnaires, and acquiring a second set of information from at least one of a plurality of interviews and at least one document review, to develop the plurality of preliminary findings, since it is well known in the art that various methods can be used to collect information. By using several methods of information collection the organization would ensure that the principles evaluated showed a true representation of the workshop and areas that may or may not be a concern for future improvement.

As per claim 3, WAGICS Evaluation Report does not explicitly teach how the preliminary information is acquired, but the tables show that information was collected to develop preliminary findings of the workshop (principles). However, it is old and well known to evaluate information collected and determine if more information is needed. By collating the first set of information, identifying at least one of a preliminary finding and information for further review, and acquiring a second set of information at least partially based upon the information for further review, the organization would ensure that the principles evaluated showed a true representation of the workshop and areas that may or may not be a concern for future improvement.

As per claim 4, WAGICS Evaluation Report teaches the voting comprises voting by a plurality of participants for a conclusion based upon each preliminary finding (table 3, page 6 – participants assess their agreement or disagreement with each of the principles; page 2 shows some of the methods used to collect participant opinions). While the Report does not explicitly teach voting occurs anonymously, it is old and well known for a participant to fill out survey responses without identifying himself. By voting anonymously, or completing the survey anonymously, one can reflect their honest opinions thereby making the results more accurate.

As per claim 5, WAGICS Evaluation Report teaches voting comprises voting by at least one assessor and at least one member of the organization (page 1, the ELSI (Ethical, Legal and Social Implications branch) put on the workshop and members of the ELSI participated in the assessment (2nd paragraph) as well as the participants of the workshop).

As per claim 6, WAGICS Evaluation Report teaches voting further comprises voting for a valuation associated with each preliminary finding, wherein the valuation associated with each

preliminary finding is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the associated characterization of the preliminary finding, and wherein said developing the plurality of final findings are further based upon said voting for the valuation based upon the characterization associated with each preliminary finding. (table 3, page 6 – participants assess their agreement or disagreement with each of the principles and their inherent characterizations; the table reflects the final findings wherein percentages are used to show overall agreement or disagreement with each of the principles)

Claims 7-12 are the computer program product for performing the method of claims 1-6, respectively. While the WAGICS Evaluation Report does not explicitly teach a computer program used to collect information, vote and present results, it would have been obvious to one of ordinary skill in the art at the time of the invention to automate the known process of collecting information, voting and displaying results since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In addition, WAGICS does not explicitly teach that the findings are labeled with the characterizations. However, examiner takes official notice that since each finding in the WAGICS report is written in such a way so as to include an inherent characterization, i.e., “suggested reading were *useful* in accomplishing workshop goals” inherently conveys a strength, it would have been obvious to one of ordinary skill in the art to actually label the findings. The inclusion of a label would provide more information for the assessor to enable him or her to provide a most accurate assessment of the organization.

As per claim 13, while the WAGICS Evaluation Report does not explicitly teach the first executable portion is adapted to at least partially acquire information via a wide area network (WAN), wherein the second executable portion is adapted to present the plurality of developed preliminary findings via the WAN, and wherein the third executable portion is adapted for voting via the WAN, it would have been obvious to one of ordinary skill in the art at the time of the invention to conduct the process using a network such as the Internet since the Internet would allow the organization to collect information, present findings and perform voting from anywhere in the world.

As per claim 14, while the WAGICS Evaluation Report does not explicitly teach the use of a WAN comprising the Internet, it would have been obvious to one of ordinary skill in the art at the time of the invention to conduct the process using a network such as the Internet since the Internet would allow the organization to collect information, present findings and perform voting from anywhere in the world.

As per claim 15, Evaluation Report teaches acquiring information concerning the organization and the process (table 3, page 6 – the principles that are evaluated are inherently reflective of the organization and the process); developing a plurality of preliminary findings based upon the information, wherein each preliminary finding has an associated characterization (table 3, page 6 – the principles that are evaluated are inherently characterize the organization and the process); voting for a valuation associated with each preliminary finding, and wherein the valuation is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the characterization of the preliminary finding (table 3, page 6 – participants assess their agreement or disagreement with each of the principles); and

developing a the at least one assessment, wherein each assessment has the characterization, and wherein the associated characterization of each assessment is based on the voting for the valuation associated with each preliminary finding (table 3, page 6 – the table reflects the final findings wherein percentages are used to show overall agreement or disagreement with each of the principles). While the WAGICS Evaluation Report does not disclose that the voting occurs electronically, it is old and well known in the art of survey and evaluation to collect responses in several methods including electronic form. It would have been obvious to one of ordinary skill in the art to perform the voting step electronically to speed the process and to make the voting process more convenient for the participants. In addition, WAGICS does not explicitly teach that the findings are labeled with the characterizations. However, examiner takes official notice that since each finding in the WAGICS report is written in such a way so as to include an inherent characterization, i.e., “suggested reading were *useful* in accomplishing workshop goals” inherently conveys a strength, it would have been obvious to one of ordinary skill in the art to actually label the findings. The inclusion of a label would provide more information for the assessor to enable him or her to provide a most accurate assessment of the organization.

As per claim 16, WAGICS Evaluation Report does not explicitly teach how the preliminary information is acquired, but the tables show that information was collected to develop preliminary findings of the workshop (principles). It would have been obvious to one of ordinary skill in the art to use several methods to acquire information including a plurality of questionnaires, and acquiring a second set of information from at least one of a plurality of interviews and at least one document review, to develop the plurality of preliminary findings, since it is well known in the art that various methods can be used to collect information. By

using several methods of information collection the organization would ensure that the principles evaluated showed a true representation of the workshop and areas that may or may not be a concern for future improvement.

As per claim 17, WAGICS Evaluation Report does not explicitly teach how the preliminary information is acquired, but the tables show that information was collected to develop preliminary findings of the workshop (principles). However, it is old and well known to evaluate information collected and determine if more information is needed. By collating the first set of information, identifying at least one of a preliminary finding and information for further review, and acquiring a second set of information at least partially based upon the information for further review, the organization would ensure that the principles evaluated showed a true representation of the workshop and areas that may or may not be a concern for future improvement.

As per claim 18, WAGICS Evaluation Report teaches the voting comprises voting by a plurality of participants for a conclusion based upon each preliminary finding (table 3, page 6 – participants assess their agreement or disagreement with each of the principles; page 2 shows some of the methods used to collect participant opinions). While the Report does not explicitly teach voting occurs anonymously, it is old and well known for a participant to fill out survey responses without identifying himself. By anonymously voting, or completing the survey, one can reflect their honest opinions thereby making the results more accurate.

As per claim 19, WAGICS Evaluation Report teaches voting comprises voting by at least one assessor and at least one member of the organization (page 1, the ELSI (Ethical, Legal and

Social Implications branch) put on the workshop and members of the ELSI participated in the assessment (2nd paragraph) as well as the participants of the workshop).

As per claim 20, WAGICS Evaluation Report teaches voting further comprises voting for a conclusion associated with each preliminary finding, wherein the conclusion associated with each preliminary finding is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the associated characterization of the preliminary finding, and wherein the at least one assessment is further based upon said voting for the valuation based upon the characterization associated with each preliminary finding. (table 3, page 6 – participants assess their agreement or disagreement with each of the principles; the table reflects the final findings wherein percentages are used to show overall agreement or disagreement with each of the principles)

(10) Response to Argument

Examiner note: Examiner has referred to cited reference as WAGICS throughout prosecution. Appellant refers to this reference as Wilkinson. They are one in the same.

Appellant argues the inherency of the acquisition of information concerning the organization and the process. The principles that are considered in the WAGICS evaluation report concern the organization and the process. As claimed, any such information that concerns any organization and/or process reads on the limitation of the claim. As for acquiring the information, the mere fact that the information is included in the assessment proves the information was previously acquired so as to enable the assessment to take place.

Appellant argues the WAGICS reference does not teach developing preliminary findings based on information concerning an organization and process thereof. Examiner asserts that the

mere fact that the information is presented to a survey participant supports the idea that this information was collected and assessed in such a way so that "preliminary findings" were developed so that participants could perform a voting operation. For example, referring to Table 3, one of the principles that are voted upon includes, "suggested readings for the Workshop are relevant". Examiner views this principle as a preliminary finding, i.e., the organization running the Workshop feels the readings are relevant and pose this principle for voting to find out if participants agree.

Appellant argues that the WAGICS reference does not disclose the preliminary findings having associated strength or weakness characterizations. As for Appellant's argument regarding strength/weakness characterizations, Examiner points out that, as claimed, the findings have an associated characterization, but the voting is for agreement or disagreement with the finding. Further, this characterization is claimed as a mere label. These labels (strength or weakness), have no affect on the methodology and therefore are considered non-functional data. While the WAGICS reference teaches voting for agreement or disagreement with findings, the reference does not explicitly teach the findings are labeled as strength or weakness. The labels are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive

material and the substrate, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); *MPEP* ? 2106.

As understood by the examiner, an associated characterization of something is viewed as an inherent trait or quality. Examiner asserts that each finding inherently has an associated characterization as either a strength or weakness of the organization, wherein each participant expresses whether or not they agree with the finding and its inherent characterization. In the WAGICS reference, most findings are characterized as inherent strengths of the organization, i.e., the readings are relevant (inherent strength of the process).

In light of Appellants arguments regarding Official Notice statements, Examiners holds that the claimed labels have no affect on the claimed invention. The labels are not functionally involved in the manipulative steps of the invention and steps of the invention would be performed the same regardless of the specific data. WAGICS teaches a strength without calling it a strength and the Official Notice statement was merely used to address a formal labeling of a "strength" as such. The conclusion of obviousness takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, labeling with a characterization of a strength or weakness is purely subjective since there are no guidelines set to distinguish a strength from a weakness.

Regarding claims 15-20, again, the claims are directed to characterizing and labeling findings, but participants only vote for agreement or disagreement with the characterization of

the finding. Examiner asserts the characterization of the finding is equated to the principles that are voted upon in the WAGICS reference. A characterization is the same as a description of something. Therefore the characterization of a finding is seen as the same as a principle as taught in the WAGICS reference.

Appellant argues the inherency of the acquisition of information concerning the organization and the process. The principles that are considered in the WAGICS evaluation report concern the organization and the process. As claimed, any such information that concerns any organization and/or process reads on the limitation of the claim. As for acquiring the information, the mere fact that the information is included in the assessment proves the information was previously acquired so as to enable the assessment to take place.

Appellant argues the WAGICS reference does not teach developing preliminary findings based on information concerning an organization and process thereof. Examiner asserts that the mere fact that the information is presented to a survey participant supports the idea that this information was collected and assessed in such a way so that "preliminary findings" were developed so that participants could perform a voting operation. For example, referring to Table 3, one of the principles that are voted upon includes, "suggested readings for the Workshop are relevant". Examiner views this principle as a preliminary finding, i.e., the organization running the Workshop feels the readings are relevant and pose this principle for voting to find out if participants agree.

Appellant argues that the WAGICS reference does not disclose the preliminary findings having associated strength or weakness characterizations. As for Appellant's argument regarding strength/weakness characterizations, Examiner points out that, as claimed, the findings

have an associated characterization, but the voting is for agreement or disagreement with the finding. Further, this characterization is claimed as a mere label. These labels (strength or weakness), have no affect on the methodology and therefore are considered non-functional data. While the WAGICS reference teaches voting for agreement or disagreement with findings, the reference does not explicitly teach the findings are labeled as strength or weakness. The labels are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP ? 2106.

As understood by the examiner, an associated characterization of something is viewed as an inherent trait or quality. Examiner asserts that each finding inherently has an associated characterization as either a strength or weakness of the organization, wherein each participant expresses whether or not they agree with the finding and its inherent characterization. In the WAGICS reference, most findings are characterized as inherent strengths of the organization, i.e., the readings are relevant (inherent strength of the process).

In light of recent Supreme Court precedent and recent Federal Circuit decisions, the claims warrant new rejections under 35 USC 101. These rejections are presented below.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent

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applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Johnna R Loftis/

Examiner, Art Unit 3624

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

Vincent Millin /vm/

Appeals Practice Specialist

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624

